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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/465,491	12/16/1999	Sheng-Yung Pai Chang	RPA1002	8931

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ROCHE MOLECULAR SYSTEMS INC
PATENT LAW DEPARTMENT
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EXAMINER

GOLDBERG, JEANINE ANNE

ART UNIT	PAPER NUMBER
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1655

DATE MAILED: 01/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/465,491

Applicant(s)

CHANG ET AL.

Examiner

Jeanine A Goldberg

Art Unit

1655

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 December 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 20 December 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.

Claim(s) objected to: NONE.

Claim(s) rejected: 1,3,5-8,10,12-21,23 and 25-27.

Claim(s) withdrawn from consideration: NONE.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other:

Continuation Sheet (PTO-303)

Continuation of 2. NOTE:

The response amends Claim 21 to recite using a pair of primers which are capable of hybridizing within exon 8 or downstream of exon 8 of the hTERT gene and a second primer capable of hybridizing upstream of exon 8 of the hTERT gene. The newly amended claim contains limitations which were not previously searched. The originally filed Claim 1 required using a primer which is within exon 8 and was subsequently amended to require specific primers. The newly amended claims do not require such a limitation, but have broadened the claim to allow for any primer which is downstream of exon 8. Moreover, the amendment does not appear to be directed to the invention as described in the specification such that it is critical that the primer be placed in the beta-deletion. Further, as argued by the response in Paper number 6, filed December 21, 2000 in response to the office action of August 28, 2000, "One of the critical aspect of the methods is the use of a primer that hybridizes within exon 8, which is a particular sub-region within the beta-region" (page 10). The newly amended claims no longer require this "critical aspect of the invention".


Additionally, search and consideration would be required for the addition of the comparison to a control sample which was not previously provided in the claim.

The claim has also added "capable of hybridizing" however, it is unclear as to capable of hybridizing under what conditions.

Finally, the response cancels the previously pending kit claims and replaces them with much broader kit claims which have not been searched nor considered. Previously the kit claims required specific sequences, such as SEQ ID NO: 2, 4 and 5. The newly added kit claim 38 is directed to any primer pair which is capable of hybridizing within exon 8 or downstream of exon 8 of the hTERT gene and a second primer capable of hybridizing upstream of exon 8. In essence, a pair of primers which amplified the entire gene would anticipate the proposed claim. The newly added kit claims also contain a set of instructions which was not previously presented.

Continuation of 5. does NOT place the application in condition for allowance because:

The arguments are drawn to the newly proposed claims which have not been entered.


W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600